

### **REMARKS**

By this Response, Applicant has canceled claims 4, 13-15, 24, 25, and 54 without prejudice or disclaimer, and amended claims 1, 3, 16-21, 38, 43, 47, 49, 51, 53, 55, and 56. Support for the amendments to claims 1, 3, 16-21, 38, 47, 49, 51, 53, 55, and 56 may be found at least in paragraphs [0026]-[0028] and claim 2 of the originally-filed application. Thus, no new matter has been added by these amendments. Claims 1, 3, 5-9, 11, 12, 16-23, 26-38, 40-53, 55, and 56 are pending in the application for examination on the merits.

In the Office Action, claims 1, 3-7, 9, 11, 13, 16, 18, 19, 47-53, and 56 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by International Patent Application No. WO 99/51815 to Husband et al. ("Husband"). Office Action at 2. Claims 8 and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Husband. Id. at 6. Claims 1, 8, 10-17, 20-36, 38, 40-46, 54, and 55 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over International Patent Application No. WO 00/59840 to Golley et al. ("Golley"). Id. at 7. Claim 37 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable based on Golley in combination with U.S. Patent No. 6,186,335 to Arrington-Webb et al. ("Arrington-Webb"). Id. at 11.

Claims 1, 21, 38, 47, 51, 55, and 56 are the only independent claims pending in the application. Applicant has amended those claims and respectfully submits that those claims comply with 35 U.S.C. § 102(b) and § 103(a) for at least the reasons outlined herein. Nevertheless, to the extent that the Examiner considers rejecting those claims based on the references of record in the application, Applicant respectfully

submits that independent claims 1, 21, 38, 47, 51, 55, and 56, as well as the claims that depend therefrom, are patentably distinguishable from those references, and such claim rejections would be improper for at least the reasons outlined herein.

**I. Claim Rejection under § 102(b) based on Husband**

With respect to the rejection of independent claims 1, 47, 51, and 56 based on Husband, Applicant respectfully submits that Husband does not disclose all of the subject matter recited in each of those independent claims. Thus, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

According to the M.P.E.P., “[t]o anticipate a claim, the reference must teach every element of the claim.” M.P.E.P. § 2131. Here, Husband does not disclose at least a kaolin having the shape factor recited in claims 1, 47, 51, and 56. Specifically, Husband does not teach, as recited in claim 1, a “composition comprising kaolin having a shape factor ranging from about 32 to 49 . . . .” Nor does Husband teach “kaolin having a shape factor of at least about 32,” as recited in each of claims 47, 51, and 56. Indeed, Husband’s Composition 4, on which the rejection statement relies for support, discloses “a high quality paper coating-grade kaolin from Georgia, US having . . . a shape factor of 30.” Husband at p. 41, ll. 13-23. Regardless of Husband’s teachings of a paper coating-grade kaolin, the shape factor of that kaolin is not within the range recited in the claims. Specifically, Husband fails to teach “kaolin having a shape factor ranging from about 32 to 49,” as recited in claim 1, or “kaolin having a shape factor of at least about 32,” as recited in claims 47, 51, and 56.

For at least the above-outlined reasons, Husband does not disclose all of the subject matter recited in claims 1, 47, 51, and 56. Thus, Husband cannot anticipate those claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 47, 51, and 56, as well as the rejected claims that depend therefrom, under 35 U.S.C. § 102(b) based on Husband.

## **II. Claim Rejection under §103(a) based on Husband**

With respect to the rejection of claims 8 and 12 under 35 U.S.C. § 103(a) based on Husband, Applicant respectfully submits that Husband fails to disclose or render *prima facie* obvious all of the subject matter recited in claims 8 and 12. For example, claims 8 and 12 depend from independent claim 1 and should be patentably distinguishable from Husband for at the reasons outlined above with respect to the § 102(b) rejection of independent claim 1 based on Husband. For at least these reasons, claims 8 and 12 are not *prima facie* obvious based on Husband. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 8 and 12 under 35 U.S.C. § 103(a) based on Husband.

## **III. Claim Rejection under § 103(a) based on Golley**

Concerning the rejection of claims 1-8, 10-17, 20-36, 38, 40-46, 54, and 55 under § 103(a) based on Golley, claims 1, 21, 38, and 55 are the only pending independent claims included in that claim rejection. (Claim 54 has been canceled.) Applicant respectfully traverses the rejection of independent claims 1, 21, 38, and 55, as well as the claims that depend therefrom, because Golley does not render the subject matter

recited in each of those claims *prima facie* obvious for at least the reasons outlined below.

In the rejection statement, the Office appears to rely on Golley's disclosure of "overlapping" ranges" with respect to the recited ranges of kaolin having an esd of less than about 0.25  $\mu\text{m}$  and the recited ranges of shape factors. See Office Action at 7. Applicant respectfully submits that independent claims 1, 21, 38, and 55 each recite ranges outside the ranges disclosed in Golley, and thus, those claims are not *prima facie* obvious based on Golley.

Independent claim 1 is directed to a composition including, *inter alia*, "kaolin having a shape factor ranging from about 32 to 49 . . . [and] an esd of less than 0.25  $\mu\text{m}$  [that] ranges from 35% to about 60% by weight." In contrast, Golley discloses kaolin having "a shape factor greater than 50 to produce even greater 'platy' clay." (Abstract.) Further, Golley discloses a pigment product where "*less than 35% by weight* of the particles have an esd smaller than 0.25  $\mu\text{m}$ ." (Id. (emphasis added).) Thus, with respect to claim 1, Golley does not disclose overlapping ranges with respect to recited range of kaolin having an esd of less than about 0.25  $\mu\text{m}$  or the recited range of shape factors. Thus, independent claim 1 is not *prima facie* obvious based on Golley.

Independent claim 21 is directed to a method of refining kaolin, including, *inter alia*, "classifying [a] kaolin slurry to obtain a kaolin having a shape factor ranging from about 20 to 49 . . . ." Since Golley discloses "a shape factor of greater than 50," Golley does not disclose an overlapping range of shape factors. Similarly, independent claim 38, also directed to a method of refining kaolin, recites, *inter alia*, "(c) classifying the slurry to a fine fraction wherein . . . the classified kaolin has a shape factor of less

than or equal to 49.” Thus, Golley does not disclose a range of shape factors overlapping with the range recited in independent claim 38. Finally, independent claim 55 is directed to a method of making a kaolin slurry, including, *inter alia*, “dewatering degrittied kaolin with an evaporator, wherein the kaolin has a shape factor ranging from about 25 to 49 . . . .” Thus, Golley also does not disclose a range of shape factors overlapping with the range recited in independent claim 55.

For at least these reasons, Golley does not disclose or render obvious all of the subject matter recited in each of independent claims 1, 21, 38, and 55. Accordingly, those claims are not *prima facie* obvious under 35 U.S.C. § 103(a) based on Golley. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 21, 38, and 55, as well as the rejected claims that depend therefrom, under § 103(a) based on Golley.

#### **IV. Rejection of Dependent Claim 37 under § 103(a)**

Turning now to the rejection of claim 37 under 35 U.S.C. § 103(a) based on Golley in combination with Arrington-Webb, claim 37 depends from independent claim 21 and should be patentably distinguishable from Golley for at least the reasons outlined above with respect to the rejection of independent claim 21 based on Golley. Moreover, Arrington-Webb fails to overcome the above-outlined deficiencies of the § 103(a) rejection of independent claim 21 based on Golley. For at least these reasons, claim 37 is not *prima facie* obvious based on the Golley and Arrington-Webb references, regardless of whether they are viewed individually or as a whole. Thus, Applicant

respectfully requests reconsideration and withdrawal of the rejection of claim 37 under 35 U.S.C. § 103(a).

**V. Conclusion**

For at least the above-outlined reasons, Applicant's independent claims 1, 21, 38, 47, 51, 55, and 56 should be allowable. Dependent claims 3, 5-9, 11, 12, 16-20, 22, 23, 26-37, 40-46, 48-50, 52, and 53 depend from a corresponding one of the allowable independent claims. Therefore, those dependent claims should be allowable for at least the same reasons as the corresponding independent claims.

Applicant respectfully requests reconsideration of the application, withdrawal of the claim rejections, and timely allowance of pending claims 1, 3, 5-9, 11, 12, 16-23, 26-38, 40-53, 55, and 56.

If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: March 23, 2009

By: \_\_\_\_\_



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